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72

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,674	01/09/2002	Anne Chew	MWH-001US	9725
25106	7590	01/30/2004	EXAMINER	
GENAISSANCE PHARMACEUTICALS 5 SCIENCE PARK NEW HAVEN, CT 06511			WOITACH, JOSEPH T	
			ART UNIT	PAPER NUMBER
			1632	

DATE MAILED: 01/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/044,674

Applicant(s)

CHEW ET AL.

Examiner

Joseph T. Weitach

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Priority

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-34 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Art Unit: 1632

DETAILED ACTION

This application filed January 9, 2002, is a continuation in part of PCT/US00/18803, filed July 10, 2000, which claims benefit to provisional application 60/143,020, filed July 9, 1999.

Claims 1-34 are pending and currently under examination.

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-10, drawn to a method of haplotyping/genotyping the tumor necrosis factor receptor superfamily member 11b gene (osteoprogenin) comprising analyzing the specific sequences set forth as PS No. 1-19, classified in class 435, subclass 440.
- II. Claims 11 and 12, drawn to a method to determine the relationship of a trait and the haplotype of the tumor necrosis factor receptor superfamily member 11b gene (osteoprogenin) comprising analyzing the specific sequences set forth as PS No. 1-19 and their association with a given trait of interest, classified in class 435, subclass 440.
- III. Claims 13-19, drawn to isolated oligonucleotides and kits for haplotyping/genotyping the tumor necrosis factor receptor superfamily member 11b gene (osteoprogenin), classified in class 536, subclass 24.33.

Art Unit: 1632

- IV. Claims 20, 21, 24, 25 and 28, drawn to an isolated polynucleotide sequence comprising the tumor necrosis factor receptor superfamily member 11b gene (osteoprogenin), classified in class 536, subclass, 23.1.
- V. Claims 22, 23, 26 and 27, drawn to a recombinant nonhuman organism comprising the tumor necrosis factor receptor superfamily member 11b gene (osteoprogenin), classified in class 800, subclass 3.
- VI. Claims 29 and 32, drawn to an isolated polypeptide comprising the tumor necrosis factor receptor superfamily member 11b gene (osteoprogenin), classified in class 530, subclass 350.
- VII. Claim 30, drawn to an isolated antibody that binds to a sequence comprising the tumor necrosis factor receptor superfamily member 11b gene (osteoprogenin), classified in class 424, subclass 130.1.
- VIII. Claim 31, drawn to a method of screening drugs that bind a polypeptide comprising the tumor necrosis factor receptor superfamily member 11b gene (osteoprogenin) protein, classified in class 436, subclass 500.
- IX. Claim 33, drawn to a computer system for storing and analyzing polymorphism data for the tumor necrosis factor receptor superfamily member 11b gene (osteoprogenin), classified in class 709, subclass 326.

Art Unit: 1632

- V. Claim 34, drawn to a genome anthology comprising the tumor necrosis factor receptor superfamily member 11b gene (osteoprogenin), classified in class 536, subclass 23.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions III, IV, V, VI, VII, IX and X are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are each drawn to products that are structurally and physically different, and can be used in different methods wherein the other products could not be used. For example the oligonucleotides can be used for PCR, the polynucleotides can be used as probes, the protein can be used to generate antibodies, the antibodies can be used to isolate the protein from a mixture, a computer can be used for other functions and the anthology can be used to generate a library for protein expression.

Inventions I, II and VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to different methods having different specific method steps and requiring different materials to practice.

Art Unit: 1632

Inventions VI and VIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the peptides can be used in a method to generate antibodies.

Inventions III and I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the oligonucleotide can be used to generate cDNA clones in the generation of expression vectors.

Because these inventions are distinct for the reasons given above and the search required for Groups I-X is not required and different for one another, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Art Unit: 1632


Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Woitach whose telephone number is (571) 272-0739.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached at (571)272-0734.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group analyst Dianiece Jacobs whose telephone number is (571)272-0532.

Joseph T. Woitach



Joe Woitach
AU1632